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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,093	09/24/2003	Alexander Tormasov	2230.0360000/MBR/GSB	6278
54089	7590	11/21/2006	EXAMINER	
BARDMESSER LAW GROUP, P.C. 910 17TH STREET, N.W. SUITE 800 WASHINGTON, DC 20006			PADMANABHAN, KAVITA	
			ART UNIT	PAPER NUMBER
			2161	

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/670,093	TORMASOV ET AL.	
	Examiner	Art Unit	
	Kavita Padmanabhan	2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 24-28 is/are rejected.
- 7) ☒ Claim(s) 20-23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Claims 1-28 are pending.
2. Claims 1, 8, 19, and 25 have been amended.
3. Claims 1-19 and 24-28 are rejected.
4. Claims 20-23 are objected to.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 8 and 25-26** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25 recites the limitation “determining a belonging to a quota area of said used quantitative parameter of file resource consumption” at lines 5-6 of the claim. However, the construction of the limitation renders it unclear. For example, it is unclear how a used quantitative parameter of file resource consumption would be determined to belong to a quota area.

The examiner will apply prior art to this claim as best understood in light of the above rejection.

Claim Rejections - 35 USC § 103

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. **Claims 1, 3, and 9-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chujo et al.** (US 2002/0023156, hereinafter "Chujo") in view of **Mane et al.** (US 2005/0050107, hereinafter "Mane").

In regards to **claim 1**, **Chujo** teaches a system for implementing a data storage quota comprising:

- a computer system including a plurality of data storage devices (**Chujo, Fig. 2**) and an authentication mechanism, said authentication mechanism having a plurality of unique identifiers and authorizing a plurality of users based upon at least one of said plurality of unique identifiers (**Chujo, par [0029], lines 5-7**);

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- a user group comprising a first set of users from said plurality of users, each of said first set of users having a first identifier of said plurality of unique identifiers (**Chujo**, par [0030], lines 17-19),
- a hierarchic computer file system organized on top of at least one of said plurality of data storage devices (**Chujo**, par [0035]), said hierarchic computer file system comprising a plurality of files, a plurality of parameters (**Chujo**, par [0035]), said plurality of parameters describing a plurality of qualitative characteristics of a level of consumption of a plurality of file system resources by said plurality of users and user group (**Chujo**, par [0036] - par [0038]);
- a quota system coupled to said hierarchic computer file system, said quota system determining a used quantitative parameter of file resource consumption that is associated with said plurality of files and can identify for at least one of said plurality of users a total value of a set of quantitative parameters of file resource consumption (**Chujo**, par [0039] - par [0042]);
- wherein said set of said quantitative parameters of file resource consumption are marked by a set of third identifiers of said plurality of unique identifiers coupled to said used quantitative parameter of file resource consumption and other quota parameters of said used quantitative parameter of file resource consumption (**Chujo**, par [0038] - par [0042]).

Chujo does not expressly teach a plurality of directories and the plurality of files arranged into a plurality of trees and having a second identifier from said plurality of unique identifiers. **Mane** teaches files arranged in directory trees (**Mane**; par [0005], lines 1-4). **Mane** also teaches files

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being identified with directory trees and directory tree quotas (**Mane, par [0005], Fig. 4**). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the system of Chujo with the file and directory structure taught by Mane whereby the directory quota id could be used in the management table of Chujo as another unique identifier in order to maintain quotas for storage resources used for storing files in selected directory trees (**Mane; par [0005], lines 1-4**).

In regards to **claim 3, Chujo and Mane** teach the system of claim 1, wherein said second identifier acts as an attribute to denote belonging to at least one of said plurality of users and said user group (**Mane, par [0005], Fig. 4**).

In regards to **claim 9, Chujo and Mane** teach the system of claim 1, wherein said plurality of unique identifiers can be within a context of an operating system (**Chujo, par [0004], par [0034]**).

In regards to **claim 10, Chujo and Mane** teach the system of claim 9, further comprising a computer network connected with said computer system and wherein said context of said operating system comprises a set of identifiers unique in said computer network (**Chujo, par [0004], par [0034]**).

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In regards to **claim 11, Chujo and Mane** teach the system of claim 9, wherein said context of said operating system comprises a set of identifiers unique on said computer system (**Chujo, par [0004], par [0034]**).

In regards to **claim 12, Chujo and Mane** teach the system of claim 9, wherein said context of said operating system comprises a set of identifiers unique to an allocated area of said computer system (**Chujo, par [0004], par [0034]; Mane, Fig. 4**).

In regards to **claim 13, Chujo and Mane** teach the system of claim 12, wherein said allocated area comprises a chroot environment (**Chujo, par [0004], par [0034]; Mane, Fig. 4 – obvious in UNIX OS that the allocated area could comprise a chroot environment; moreover UNIX is a chroot environment**).

In regards to **claim 14, Chujo and Mane** teach the system of claim 12, wherein said allocated area comprises a virtual environment (**Mane, par [0041]**).

In regards to **claim 15, Chujo and Mane** teach the system of claim 1, wherein said plurality of parameters of said hierarchic computer file system comprises at least one of a consumption parameter on a size of at least one of said plurality of data storage devices associated with at least one of said plurality of users and said user group, a consumption parameter on a number of various auxiliary file system structures used to arrange files of at least one of said plurality of users and said user group, a consumption parameter on other parameters

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of auxiliary operations performed by an operating system to serve at least one of said plurality of users and said user group during a period of time, and a consumption parameter on a time and range of modifications of any of said above consumption parameters that allow a user to modify already defined limitations (**Chujo, par [0039] - par [0042]**).

In regards to **claim 16, Chujo and Mane** teach the system of claim 1, wherein said quota system can operate with said hierarchic computer file system and does not require modification of a manner in which data and file metadata are represented in said hierarchic computer file system, as well as a way of representing file system service data in said at least one of said plurality of data storage devices organized below said hierarchic computer file system (**Chujo, par [0039] - par [0042]; Mane, Fig. 4**).

10. **Claims 2 and 4-8** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chujo in view of Mane**, further in view of **Inglett** (US 5,905,990).

In regards to **claim 2, 4, and 7, Chujo and Mane** teach the system of claim 1. Chujo and Mane do not expressly teach the file system having a hidden root directory that is not visible to said plurality of users and a specific data storage space mounted to an available directory area, said specific data storage area comprising a second computer file system. **Inglett** teaches creating mountpoint directories wherein files can be manifested (**Inglett, abstract**) and also teaches directories being made visible, therefore suggesting that they were previously not visible (**Inglett, col. 4, lines 39-41**). It would have been obvious to one of ordinary skill in the art at the

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time of the applicant's invention to implement the system of Chujo and Mane using these feature of Inglett in order to provide added flexibility to the file system (**Inglett, col. 4, lines 29-32**).

In regards to **claim 5, Chujo, Mane, and Inglett** teach the system of claim 4, wherein said second computer file system is mounted inside said available directory of said hierarchic computer file system, wherein after said second computer file system is mounted, said computer system has an opportunity to use said second computer file system as an extension of said hierarchic computer file system (**Inglett, abstract**).

In regards to **claim 6, Chujo, Mane, and Inglett** teach the system of claim 4, wherein after said second computer file system is mounted, said second computer file system becomes a part of a new tree of said hierarchic computer file system (**Inglett, abstract; Mane, par [0005], lines 1-4**).

In regards to **claim 8, Chujo, Mane, and Inglett** teach the system of claim 7, wherein said plurality of mounting objects comprise a plurality of file system volumes and a plurality of file system sub-trees (**Inglett, abstract; Mane, par [0005], lines 1-4, Fig. 7**).

11. **Claims 17-19 and 24-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chujo in view of Mane, further in view of Inglett, and further in view of Byrnes (US 6,832,248)**.

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In regards to **claim 17**, **Chujo** teaches a method for implementing a data storage quota comprising:

- authorizing a plurality of users within a computer system with a plurality of unique identifiers of any context of an operating system (**Chujo**, par [0029], lines 5-7);
- grouping a first set of users of said plurality of users in a user group, each of said first set of users having at least one of said plurality of unique identifiers (**Chujo**, par [0030], lines 17-19);
- organizing a hierarchic computer file system on top of a data storage device, wherein said hierarchic computer file system comprises a plurality of files, a plurality of parameters (**Chujo**, par [0035])
- describing qualitative characteristics of a level of consumption of a plurality of resources of said hierarchic computer file system by at least one of said plurality of users and said user group via said plurality parameters of said hierarchic computer file system (**Chujo**, par [0036] - par [0038]); and
- calculating a used quantitative parameter of file resource consumption associated with said plurality of files (**Chujo**, par [0039] - par [0042]).

Chujo does not expressly teach arranging said plurality of files into a plurality of trees, wherein each of said plurality of files has at least one of said plurality of unique identifiers to act as an attribute which denotes belonging to at least one of said plurality of users and said user group, mounting a specific data storage area as a second file system inside any available directory of said hierarchic computer file system, wherein after said mounting of said specific data storage area said computer system can use said second file system as an extension of a new tree of said

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hierarchic computer file system, and telling at least one of said plurality of users a total value of a set of quantitative parameters of file resource consumption using said used quantitative parameter of file resource consumption.

Mane teaches files arranged in directory trees (**Mane; par [0005], lines 1-4**). **Mane** also teaches files being identified with directory trees and directory tree quotas (**Mane, par [0005], Fig. 4**). **Inglett** teaches creating a mountpoint directory wherein files can be manifested (**Inglett, abstract**). **Byrnes** teaches sending a notification to a user based on quota usage (**Byrnes, Fig. 5, reference character 530**).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the method of Chujo with the file and directory structure taught by Mane, whereby the directory quota id could be used in the management table of Chujo as another unique identifier, in order to maintain quotas for storage resources used for storing files in selected directory trees (**Mane; par [0005], lines 1-4**). It would also have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the method of Chujo and Mane by using a mountpoint directory, as taught by Inglett, in an available directory of the system of Chujo and Mane in order to provide added flexibility to the file system (**Inglett, col. 4, lines 29-32**) and to incorporate the notification feature taught by Byrnes so that users could be notified of their file resource consumption information (**Byrnes, Fig. 5, reference character 530**).

In regards to **claim 18**, **Chujo, Mane, Inglett, and Byrnes** teach the method of claim 17, wherein said calculating step further comprises:

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- coupling a set of identifiers from said plurality of unique identifiers to said used quantitative parameter of file resource consumption (**Chujo, par [0036] – par [0038]**); and
- marking said set of quantitative parameters of file resource consumption with said set of identifiers from said plurality of unique identifiers and other quota parameters of said used quantitative parameter of file resource consumption (**Chujo, par [0036] – par [0038]**).

In regards to **claim 19, Chujo, Mane, Inglett, and Byrnes** teach the method of claim 17, wherein a set of directories within said plurality of directories comprises a plurality of mounting points of said hierarchic computer file system, wherein said plurality of mounting points are located inside said hierarchic computer file system, and wherein a file system volume and a file system sub-tree can each be used as a mounting object for said plurality of mounting points (**Inglett, abstract; Mane, par [0005], lines 1-4, Fig. 7**).

In regards to **claim 24, Chujo, Mane, Inglett, and Byrnes** teach the method of claim 17, wherein said calculating step further comprises:

- releasing an allocated area size and a plurality of other data storage parameters (**Chujo, par [0039] - par [0043]**); and
- modifying said allocated area size and said plurality of other data storage parameters (**Chujo, par [0039] - par [0042], par [0064]**).

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In regards to **claim 25, Chujo, Mane, Inglett, and Byrnes** teach the method of claim 24, wherein said releasing and modifying step comprises:

- defining a belonging of said used quantitative parameter of file resource consumption to at least one of said plurality of files of said hierarchic computer file system (**Chujo, par [0039] - par [0042]; Mane, par [0005], Fig. 4**);
- determining a belonging to a quota area of said used quantitative parameter of file resource consumption (**Chujo, par [0039] - par [0042]; Mane, par [0005], Fig. 4**);
- determining at least one of said plurality of unique identifiers (**Chujo, par [0030], lines 17-19**);
- detecting a plurality of current values of said plurality of parameters (**Chujo, par [0038], lines 2-3, par [0040] – par [0042], par [0046]**);
- identifying a plurality of limitations associated with said plurality of parameters based on at least one of said plurality of users and said user group (**Chujo, par [0040] – par [0042], par [0046]**);
- updating in at least one of a special file, a data storage area, and a computer operating memory, and a special server of said detected current values and said identified limitations (**Chujo, par [0040] - par [0042], par [0046], par [0064]**);
- comparing said identified limitations with a current value of a storage usage, a current state of said computer system, a current state of said hierarchic computer file system and a requested size for an allocated space and other parameters of data storage (**Chujo, par [0040] - par [0042], par [0046]**); and

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- determining a permission to a required operation of said computer system based on said comparing step and an execution of said required operation (**Chujo, par [0039]; Byrnes, Fig. 5, reference character 530**) .

In regards to **claim 26, Chujo, Mane, Inglett, and Byrnes** teach the method of claim 25, wherein said releasing and modifying steps are performed by at least one of a special program of said operating system and a kernel of said operating system (**Chujo, par [0004], par [0034]**).

In regards to **claim 27, Chujo, Mane, Inglett, and Byrnes** teach the method of claim 17, wherein said plurality of parameters of said hierarchic computer file system comprises at least one of a consumption parameter on a size of at least one of said plurality of data storage devices associated with at least one of said plurality of users and said user group, a consumption parameter on a number of various auxiliary file system structures used to arrange files of at least one of said plurality of users and said user group, a consumption parameter on other parameters of auxiliary operations performed by an operating system to serve at least one of said plurality of users and said user group during a period of time, and a consumption parameter on a time and range of modifications of any of said above consumption parameters that allows for use by a user to modify already defined limitations (**Chujo, par [0039] - par [0042]**).

In regards to **claim 28, Chujo, Mane, Inglett, and Byrnes** teach the method of claim 17, said calculating step can operate on top of said hierarchic computer file system and does not require modification of any manner in which data and file metadata are represented, as well as

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any way file system service data is represented in said storage device of said hierarchic computer file system (**Chujo**, par [0039] - par [0042]; **Mane**, Fig. 4).

Allowable Subject Matter

12. **Claims 20-23** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Amendment

13. Applicant's amendments filed 9/15/06 with respect to the claim objections have been fully considered. The objections to the claims have been withdrawn accordingly.

14. Applicant's amendments filed 9/15/06 with respect to the 35 U.S.C. 112, 2nd paragraph rejections have been fully considered. However, claim 25 is still rejected under 35 U.S.C. 112, 2nd paragraph for reasons stated above.

Response to Arguments

15. The declaration filed on 9/15/06 under 37 CFR 1.131 has been considered but is ineffective to overcome the Mane reference. The 35 U.S.C. 103(a) rejections of claims 1-19 and 24-28 have therefore been maintained.

16. An affidavit is a statement in writing made under oath before a notary public, magistrate, or officer authorized to administer oaths. See MPEP § 604 through § 604.06 for additional information regarding formal requirements of affidavits.

37 CFR 1.68 permits a declaration to be used instead of an affidavit. The declaration must include an acknowledgment by the declarant that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon. The declarant must set forth in the body of the declaration that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true.

Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s). Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims.

Applicant states in the Transmittal document, dated 9/15/06, that the following items have been transmitted with that document:

1. Amendment and Reply under 37 C.F.R. 1.111
2. Declaration under 37 C.F.R. 1.131
3. Exhibits A, B, C for the Declaration under 37 C.F.R. 1.131

However, there does not appear to be either a Declaration under 37 C.F.R. 1.131 or an Exhibit C included with the applicant's submission.

17. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Mane reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure

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to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131. 37 CFR 1.131(b) requires that original exhibits of drawings or records, or photocopies thereof, accompany and form part of the affidavit or declaration or their absence satisfactorily explained. In *Ex parte Donovan*, 1890 C.D. 109, 52 O.G. 309 (Comm'r Pat. 1890) the court stated

If the applicant made sketches he should so state, and produce and describe them; if the sketches were made and lost, and their contents remembered, they should be reproduced and furnished in place of the originals. The same course should be pursued if the disclosure was by means of models. If neither sketches nor models are relied upon, but it is claimed that verbal disclosures, sufficiently clear to indicate definite conception of the invention, were made the witness should state as nearly as possible the language used in imparting knowledge of the invention to others.

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date.

Applicant states on page 13 of applicant's remarks that "a Rule 131 declaration is submitted, showing a date of conception of the invention prior to September 3, 2003 (the filing date of Mane et al.)."

However, such a declaration does not appear to have been submitted.

18. The evidence submitted is insufficient to establish diligence from a date prior to the reference date of the Mane reference to either a constructive reduction to practice or an actual reduction to practice.

Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence.

In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958).

What is meant by diligence is brought out in *Christie v. Seybold*, 1893 C.D. 515, 64 O.G. 1650 (6th Cir. 1893). In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that the record must set forth an explanation or excuse for the inactivity; the USPTO or courts will not speculate on possible explanations for delay or inactivity. See *In re Nelson*, 420 F.2d 1079, 164 USPQ 458 (CCPA 1970). Diligence must be judged on the basis of the particular

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facts in each case. See MPEP § 2138.06 for a detailed discussion of the diligence requirement for proving prior invention.

Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. The “lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon” is not relevant to an affidavit or declaration under 37 CFR 1.131. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947). Form paragraph 7.62 (reproduced in MPEP § 715) may be used to respond to a 37 CFR 1.131 affidavit where diligence is lacking.

Applicant states on page 14 of applicant’s remarks that “as discussed in the Rule 131 declaration, during the relevant period ... one of the inventors, Alexander Tormasov, has had several telephone conversations with OMM regarding the issue of a foreign filing license required from Singapore.”

However, such a 131 declaration detailing such information does not appear to have been submitted.

Conclusion

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Kavita Padmanabhan** whose telephone number is **571-272-8352**. The examiner can normally be reached on Monday-Friday, 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kavita Padmanabhan
Assistant Examiner
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K.P.

November 14, 2006


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